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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,134	12/29/2000	Gary L. Shanklin	659/766	1798
757	7590	02/23/2006	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			SALVATORE, LYNDIA	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 02/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,134

Applicant(s)

SHANKLIN, GARY L.

Examiner

Lynda M. Salvatore

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 10-20 and 22-47 is/are pending in the application.
- 4a) Of the above claim(s) 23-34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 10-20 and 22 is/are allowed.
- 6) ☒ Claim(s) 35-41 and 46 is/are rejected.
- 7) ☒ Claim(s) 42-45 and 47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's remarks filed 11/28/05 have been fully considered and entered. Applicant's remarks regarding the obviousness rejection set forth in section 6 of the last Office Action are not found persuasive of patentability for reasons set forth herein below.

Terminal Disclaimer

2. The terminal disclaimer filed on 11/28/05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of co-pending application No. US 2004/0086726 A1 has been reviewed and is accepted. The terminal disclaimer has been recorded. Accordingly, the obviousness-type double patenting rejections made over said co-pending application as set forth in sections 3 and 4 of the last Office Action are hereby withdrawn.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 35-41 and 46 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rothe et al., US 4,738,847 in view of Walter et al., US 4,950,545 or US 5,227,242.

Applicant argues a lack of motivation to combine references and asserts that the Examiner is attempting to impart the inappropriate "obvious to try" rationale. This argument is not found persuasive. The Examiner maintains that sufficient motivation exists to provide the multi-ply absorbent article comprising the virucidal composition of Roth et al., with a siloxane composition as taught by Walter et al. Specific motivation is found in the teachings of the

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secondary reference of Walter et al., to impart softness to the absorbent multi-ply tissue article with a siloxane composition. Thus, since Walter et al., explicitly teach imparting softness with the siloxane composition it is the position of the Examiner that there is no obvious to try rationale.

Applicant also argues that there is no reasonable expectation of success when the cited references are combined because the siloxane composition would be expected to migrate from the top layer of the multi-layered material into the inner layers. Applicant submits that the migrated siloxane may interact with the other ingredients within the layers of the tissues. In response, Applicant is only claiming a siloxane composition applied to the outer surface of the multi-ply article. Applicant has not set forth any limitations or features of the siloxane composition or the top layer of the multi-ply material, which would prevent migration of the siloxane composition. Nor is there any suggestion supplied by the cited references that if siloxane migration occurs it negatively impacts the other ingredients within the layer. If preventing siloxane migration is a critical feature to Applicant's invention and/or if it can be shown that the particular siloxane composition taught by Walter et al., negatively impacts the other ingredients of the material or reduces the efficacy of the virucidal composition of Rothe et al., then it is suggested that Applicant evidence such assertions and/or provide limitations/features which function to prevent or preclude siloxane migration.

Recall, the patent issued to Rothe et al., disclose a multi-ply absorbent article comprising a virucidal composition confined to the inner layer of the product (Abstract). Preferably the absorbent article comprises three plies, wherein the inner or middle layer further comprises a virucidally effective amount of a virucidal composition (Column 1, lines 22-35). Rothe et al.,

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teach applying the virucidal composition to the inner ply layer to reduce any irritation that may result from having the virucidal composition present on the surface of the article (Column 2, lines 10-20). The plies may be made from webs of cellulosic creped wadding, however, non-woven webs synthetic polymeric fibers are also suitable (Column 2, lines 47-54). The three-ply absorbent article is suitable for use as facial tissues, bathroom tissues, paper towels or wipes (Column 1, lines 36-39). Suitable virucidal compositions include acids having the formula $R-COOH$, wherein R is selected from the group of lower alkyl; substituted lower alkyl; carboxy lower alkyl or carboxy dihydroxy (Column 1, lines 40-60).

Rothe et al., fail to teach adding a at least one siloxane composition to at least one outer ply, however, the patent issued to Walter et al., teach applying a silicone compound to facial tissues to improve softness (Abstract '545 and '242). Suitable silicone compositions include various ganommodified polysiloxanes and mixtures of cyclic and non-cyclic-modified dimethyl siloxane (Column 2, 5-23-'545 and '242). Walter et al., specifically teaches printing the silicone compound onto the outer surfaces of the tissue (Column 6, 30-40-'545 and '242).

Therefore, motivated by the desire to provide a anti-microbial tissue product with improved softness, the Examiner maintains that it would have been obvious to one having ordinary skill in the art at the time the invention was made to the print the outer surface of the multi-ply tissue product taught by Roth et al., with the silicone/siloxane compounds taught by Walter et al.

Allowable Subject Matter

5. Claims 42-45 and 47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Specifically, the combination of prior art fails to teach the claimed amine-modified polysiloxane composition.

6. The following is a statement of reasons for the indication of allowable subject matter: Claims 1-6,10-20 and 22 are found allowable. Specifically, the combination of prior art fails to teach the claimed amine-modified polysiloxane composition. An updated art search did not produce any new substantial art for which to base a rejection and presently there is no motivation to combine references to form an obviousness type rejection.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M. Salvatore whose telephone number is 571-272-1482.


The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 14, 2006

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